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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,450	10/23/2003	Ajay Kapur	RD28357-1/YOD (GERD:0220)	8030
41838 7590 05/29/2009 GENERAL ELECTRIC COMPANY (PCPI) C/O FLETCHER YODER P. O. BOX 692289 HOUSTON, TX 77269-2289			EXAMINER WANG, CLAIRE X	
			ART UNIT 2624	PAPER NUMBER
			MAIL DATE 05/29/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/692,450	Applicant(s) KAPUR ET AL.	
	Examiner CLAIRE WANG	Art Unit 2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 March 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 20-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicants' response to the last Office Action, filed on March 2nd, 2009 has been entered and made of record.

Response to Arguments

2. Applicant's arguments filed March 2nd, 2009 have been fully considered but they are not persuasive.

- a. In response to applicant's remarks regarding claim rejection made under 35 U.S.C. 101, it noted that While said claim discloses a system on which the method is operating it is noted that "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one. Also, the process does not transform the images into a different state and thus does not meet the transformation requirements. Therefore, the claim rejection of claims 1-7 and 12-23, made under 35 U.S.C. 101 is maintained.

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b. In response to applicant's remarks that Burke does not teach every element of the independent claim 1, it is noted that the examiner respectfully disagree. It is noted that Burke teaches an x-ray or other radiographic device used to image the breast (Col. 5, lines 25-26) and the image is scanned into the system and registered by a coarse registration step (Col. 15, lines 7-22). Burke further teaches that a ROI is identified (Col. 15, lines 31-32). Then the corresponding ROI in the actual breast is then scanned an ultrasound (Col. 15, lines 41-45). Therefore, the examiner believe that Burke reads the entirety of claim 1.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-7 and 12-23 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim(s) recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, claim 1 recites the steps of scanning, determining and using, it is noted that even though image systems are in the claim language, it is noted that “the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter.” Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)).

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 6 and 8-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke et al. (US 6,421,454, B1 hereinafter “Burke”).

As to claim 1, Burke teaches a method for viewing an abnormality in different kinds of images (optical correlator assisted detection for breast biopsy; Title), said method comprising: scanning an object using a first imaging system to obtain at least a first image of the object (a film scanner scans in the radiographic image into the system and registers by a coarse registration step; Col. 15, lines 7-22); determining coordinates of a region of interest (ROI) visible on the first image (a ROI can be identified by a computer aided diagnosis system; Col. 15, lines 31-32 since the ROI is identified by a computer then the coordinate must be determined), wherein the ROI includes the abnormality (system for breast biopsy; Title); and using the coordinates of the ROI to scan the object with a second imaging system (the ROI of the breast is then scanned by the ultrasonographic equipment at a high resolution setting; Col. 15, lines 42-45).

As to claim 2, Burke teaches wherein determining coordinates of the ROI visible on the first image comprises manually marking the ROI on a display device that displays the first image (the ROI is marked either manually by an operator input or by a computer aided diagnosis system; Col. 15, lines 23-35).

As to claim 3, Burke teaches wherein determining coordinates of the ROI visible on the first image comprises automatically marking the ROI by using a computer-aided design (CAD) algorithm (the ROI is marked either manually by an operator input or by a computer aided diagnosis system; Col. 15, lines 23-35).

As to claim 6, Burke teaches registering 2-dimensional (2D) data from which the first image is generated with 3-dimensional (3D) data obtained by scanning the object with the second imaging system (develop and store 3D image data set after scanning with ultrasound in higher resolution; 240 and 242 Figs. 9a-9b).

As to claims 8-10, they are the same as claims 1-3. The only difference is that Claims 8-10 are system claim, whereas claims 1-3 are method claims. Therefore, claims 8-10 are analyzed in the same way as claims 1-3. Please see above for details.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-5, 11-15, and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke in view of Wang et al. (US 2003/0007598 A1 hereinafter "Wang").

As to claim 4, Burke teaches an ultrasound system wherein a probe is used (scan head probe; Col. 7, lines 9-15) and scanning the specific region of the object with the second imaging system to obtain at least one second image (the ROI of the breast is then scanned by the ultrasonographic equipment at a high resolution setting; Col. 15, lines 42-45). Wang teaches a breast cancer screening with adjunctive ultrasound mammography (Title) wherein a mechanical translation mechanism moves the ultrasound probe across the breast as ultrasound scans are taken ([0030], lines 7-9). Thus, Wang reads on the claimed instructing a probe mover to move a probe to the coordinates to scan a specific region of the object. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to combine Burke's ultrasound system with the mechanical probe mover in order to accurately move the ultrasound probe to the desired location.

As to claim 5, Wang teaches displaying the first and the second images concurrently to enable a user to view the abnormality (the ultrasound display has one or more adjunct display monitors positioned near the x-ray mammogram display so the radiologist is able to view both at the same time; [0033], lines 7-13).

As to claim 11, it is the system claim of claim 4. Therefore, it is analyzed in the same way. Please see above for detail analysis.

As to claim 12, it differs from claim 1 in that claim 12 further teaches registering 3-dimensional (3D) data relative to 2-dimensional (2D) data, wherein the 3D data is obtained using the second imaging system and the 2D data is obtained using the first imaging system. Wang teaches scanning the ROI using both X-ray and ultrasound wherein the X-ray is the 2D data generator and the ultrasound is the 3D image generator ([0044], lines 1-8). Thus, Wang reads on the claimed registering 3D image data with the second system and the 2D image data with the first system. Therefore, it would have been obvious for one ordinarily skilled in the art at the time the invention was made to combine the 2 system of Burke with the 2D and 3D systems of Wang, Since it's well known in the art that X-ray is capable of generating 2D images and ultrasound is capable of generating 3D images.

As to claim 13, Wang teaches wherein registering 3D data relative to 2D data comprises registering 3D data relative to 2D data without using fiducial marks on a patient having the abnormality (correlating the ROI using nipple distance information; [0044], lines 10-19).

As to claim 14, Wang teaches wherein registering 3D data relative to 2D data comprises registering 3D data acquired using an ultrasound imaging system relative to 2D data acquired using an X-ray imaging system (Wang teaches scanning the ROI using both X-ray and ultrasound wherein the X-ray is the 2D data generator and the ultrasound is the 3D image generator; [0044], lines 1-8).

As to claim 15, Wang teaches establishing a relationship between the 3D data acquired using the ultrasound imaging system and the 2D data acquired using the X-ray imaging system (Wang teaches scanning the ROI using both X-ray and ultrasound wherein the X-ray is the 2D data generator and the ultrasound is the 3D image generator; [0044], lines 1-8).

As to claim 21, it is the combination of claims 1 and 4. Thus it is analyzed in the same way. Please see above for detail analysis.

As to claim 22, it is the same as claim 2. Therefore, claim 22 is analyzed in the same way as claim 2.

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As to claim 23, it is the same as claim 3. Therefore, claim 23 is analyzed in the same way as claim 3.

As to claim 24, it is the same as claim 21. The only difference is that Claim 24 is a system claim, whereas claim 21 is a method claim. Therefore, claim 24 is analyzed in the same way as claim 21.

As to claim 25, it is the same as claim 21. The only difference between the two claims is claim 25 fails to teach the scanning and determining coordinates part of claim 21. Also, claim 25 is a system whereas claim 21 is a method.

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9. Claims 7, 16, 20 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burke in view of Fu et al. (US 2005/0047544 A1 hereinafter "Fu").

As to claim 7, Fu teaches the differences in the position and orientation of the anatomical target images within radiographs correspond to the difference in the 3D position with in a target 3D coordinate frame are solved by finding the parameters (s, y, z, r, p, w). Thus Fu's parameters read on the claimed 6 unknowns. Therefore, it would have been obvious to one ordinarily skilled in the art at the time of the invention to combine Burke's radiographic and ultrasound system with Fu's correlation parameters in order to have a precise and rapid way to register 2D images with 3D scan data (Fu [0009] lines 1-3).

As to claim 16, it is the same as claim 7. The only difference between the two claims is claim 16 further teaches that 2D data is gathered using an X-ray and the 3D data is gathered using an ultrasound (Burke teaches develop and store 3D image data set after scanning with ultrasound in higher resolution; 240 and 242 Figs. 9a-9b). Therefore, claim 16 is analyzed in the same way as claim 7.

As to claim 20, Fu teaches obtaining six additional equations having six additional unknowns, wherein each of the six additional equations establishes a relationship between coordinates of 2D data acquired from the X-ray imaging system and coordinates of 3D data acquired from the ultrasound imaging system; solving the six additional equations to obtain the six additional unknowns; and averaging a first unknown of the six unknowns with a corresponding first additional unknown of the six additional unknowns (Fig. 3 shows the different ways of finding and relating the 6 unknowns through multi-dimensional matching).

As to claim 26, it is the system claim of 7. Therefore, claim 26 is analyzed in the same way as claim 7.

Allowable Subject Matter

10. Claims 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding claim 17, the innovation distinction that makes the claim allowable is the three equations defined by the claim.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLAIRE WANG whose telephone number is (571)270-1051. The examiner can normally be reached on M-F 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Werner can be reached on 571-272-7401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Claire X. Wang/
05/25/2009

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